I. Claims 1-51 and 73-80, drawn to an in vitro process for producing more than one copy of a nucleic acid, classified in Class 435, subclass 91.2.;

II. Claims 52-72, drawn to a promoter-independent non-naturally occurring nucleic acid construct which when present in a cell produces a nucleic acid without the use of any gene product coded by said construct, and nucleic acid conjugates of this construct, classified in Class 435, subclass 320.1, for example; and

III. Claims 81-90, drawn to a construct comprising a host promoter located on the construct such that the host transcribes a sequence in the construct coding for a different RNA polymerase, classified in Class 435, subclass 69.1 for example.

The Examiner maintained that the inventions of the groups are distinct since the process of group I may allegedly be practiced without the constructs of groups II and III (e.g., by using RNA primers). Further, the Examiner maintains that the products of groups II and III may be used in different processes; group II products may be used in processes that involve the controllable regulation of gene expression for the overproduction of proteins, while the products of group III may be used in a method of purification of RNA polymerases.

With respect to groups II and III, the Examiner maintains that these groups are related as combination and subcombination. In the instant case, the Examiner argues that of group II does not require the particulars of the subcombination of group III (because the construct of group I does not require a nucleic acid sequence encoding a polymerase) and that the subcombination of group III has separate utility from that of the combination of group II, such as overexpressing RNA polymerase for the purpose of purifying a protein.

In compliance with the Code of Federal Regulation, applicants hereby elect, with traverse, claims 1-51 and 73-80 of Group I. Applicants respectfully request, however, that the restriction requirement under 35 U.S.C. §121 be reconsidered and withdrawn in view of the remarks set forth below.

The claims represented by Groups I, II and III form a single general inventive concept which should be properly examined in the same application. Applicants contend that a diligent search of the art for any of these three groups would necessitate a review of the art -- at least in part -- for the other corresponding groups. This position is particularly supported by the fact that each of the claim groups are classified in Class 435.

Under M.P.E.P. §803, two criteria are necessary in order for a restriction requirment between patentably distinct inventions to be proper:

(1) The inventions must be independent or distinct as claimed; and

(2) there must be a serious burden on the Examiner if restriction is not required.

It is respectfully submitted that a search of the prior art for the process (defined by Group I, claims 1-51 and 73-80) would necessitate a search of the art pertinent to the constructs of Groups II and III (defined by claims 52-72 and 81-90). Accordingly, examining Groups II and III in the present application, would not place a serious burden on the Patent Office or the Examiner in light of the search that will already be required for the provisionally elected process claims of Group I. Applicants are firmly of the opinion that a search for the invention of Group I, diligently undertaken, would inevitably overlap with the subject matter covered by Groups II and III. Because the Examiner is expected to and will no doubt carry out a diligent search of the prior art. Applicants submit that no serious burden would be imposed in terms of the search effort if she properly includes the subject matter of Groups II and III with the subject matter of Group I.

In effect, all three groups define subject matter pertaining to the in vitro process for producing more than one copy of a nucleic acid as set forth in Claim 1. To require restriction in this instance, will -- in effect -- hamper the current prosecution because it draws attention away from the single general inventive concept unifying all the pending claims.

Moreover, it is submitted the instant restriction requirement will only serve to duplicate the search efforts of the Patent Office and other examiners in future filings necessitated by the requirement, in the event it is maintained. The instant Assigneee will also be burdened unfairly by the additional cost for such future filings, the subject matter of all of which should be properly examined in the instant application.

Applicants sincerely believe that if the Examiner carefully considers the arguments above, she too, will reasonably conclude that a serious burden in terms of search efforts will not be placed upon the Patent Office or herself, if the claims of Groups II and III are properly examined in this application, together with the elected claims of Group I. Applicants earnestly urge, therefore, that the Examiner reconsider and withdraw the restriction requirement on the basis of the foregoing remarks. Applicants also believe examination of all three claim groups in a single application is consistent with the intent and spirit of the GATT provisions recently adopted by the U.S., regarding unity of invention.

In view of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the restriction requirment. Full examination of claims 1-90 on the merits is believed to be in order.

This response is accompanying a Petition To Review An Unintentionally Abandoned Application Under 37 C.F.R. §1.137(b) and authorization for the fee therefor. The Patent and Trademark Office is hereby authorized to charge Deposit Account No. 05-1135 for any other fees in connection with the Petition or this response, and to credit any overpayment thereto. Should it be

deemed helpful or necessary, the Examiner is respectfully invited to telephone the undersigned at (212) 583-0100 to discuss the subject application.

Respectfully submitted,

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